REMARKS

Claim Rejections - 35 USC § 102

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al. (US 2004/0198916).

This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Claim 1 now recites "*subsequently* mixing the epoxy silane represented by the general formula (a1), the carboxylic acid represented by formula (a2), the metal salt of the carboxylic acid represented by the general formula (a2) and water." Nakamura fails to disclose this limitation. In particular, Nakamura fails to disclose first "obtaining a metal salt of the carboxylic acid represented by the general formula (a2)" and "*subsequently* mixing the epoxy silane represented by the general formula (a1), the carboxylic acid represented by formula (a2), the metal salt of the carboxylic acid represented by the general formula (a2) and water." In *Lewmar Marine*, the Federal Circuit reversed the trial court's holding of anticipation based on the lower court's ignoring of the word "only" in the claims. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 749 (Fed. Cir. 1987)("The claim limitation could possibly read on the American Eagle winch if the word "only" did not appear in that clause. The word 'only,' however, is there and may not be read out of the claim.") Applicants submit that use of the word "subsequently" in the present claims, as in the claims in *Lewmar Marine*, render the claims distinguishable from the applied prior art. Applicants respectfully request withdrawal of the rejection.

Claim Rejections - 35 USC § 103

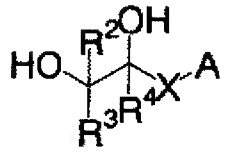
Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (US 2004/0198916), in view of Inoue et al. (US 5,891,356).

This rejection is respectfully traversed.

Nakamura fails to disclose first "obtaining a metal salt of the carboxylic acid represented by the general formula (a2)" and "*subsequently* mixing the epoxy silane represented by the general formula (a1), the carboxylic acid represented by formula (a2), the metal salt of the carboxylic acid represented by the general formula (a2) and water." Furthermore, Inoue fails to fill this gap. Thus, Nakamura and Inoue fail to teach or suggest the invention of claim 1 *as a whole*.

In Nakamura, the carboxylic acid and the metal hydroxide are mixed together with the epoxy silane. As a result, the purity of the silicone compound of Nakamura is lower than the silicone of the present invention because a metal hydroxide such as potassium hydroxide shows strong alkalinity, thereby the reaction of the metal hydroxide and silicone is unavoidable. By avoiding the inclusion of a metal hydroxide in the mix of the epoxy silane, carboxylic acid, the metal salt carboxylic acid and water in the present invention, the inventors have been able to prepare silicone having much higher purity than the silicone prepared by the process of Nakamura.

For example, by the process of this invention, the amount of the compound of formula (y) is 0.4% or more and 3% or less,



(y)

and the purity of the silicone compound is 87% or more as recited in claim 9. These results are totally unexpected as compared to the silicone made by the process of Namakura.

New process claims 7-10 are fully supported by the limitations of claims 4-6.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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